

REMARKS

In the Office Action issued on June 18, 2008, the Examiner:

- rejected claims 1, 2 and 8 under 35 U.S.C. §102(b) as being anticipated by Shaknovich (United States Patent No. 5,807,398);
- rejected claims 4 and 11 under 35 U.S.C. §103(a) as being unpatentably obvious over Shaknovich in view of Kirkman (United States Patent No. 6,071,263);
- rejected claim 12 under 35 U.S.C. §103(a) as being unpatentably obvious over Shaknovich in view of Pavcnik (United States Published Application No. 20010039450);
- rejected claims 13 and 14 under 35 U.S.C. §103(a) as being unpatentably obvious over Shaknovich in view of Levine (United States Published Application No. 20040087965);
- rejected claim 18 under 35 U.S.C. §103(a) as being unpatentably obvious over Shaknovich in view of Levine and further in view of Pavcnik.

The Applicants have fully considered the Office Action and cited references and submit this Reply and Amendment in response to the Examiner's objections and rejections. Reconsideration of the application for patent is requested.

Preliminary matter – Summary of Interview conducted on June 27, 2008

The undersigned attorney thanks the Examiner for the telephone interview

held on June 27, 2008. In the interview, the amendments made herein to independent Claim 1 were discussed in comparison to Shaknovich. Figures 5 and 6 of the current application were discussed as examples of the spacing conducted in the claimed method, in which *an axial portion of the elongate member disposed between the proximal end of the means for spacing and the distal end of the intraluminal medical device is free of contact with the wall surface of the body vessel.*

Figure 5 of Shaknovich was specifically discussed in contrast to the amendments made to Claim 1 to illustrate the type of spacing accomplished by the conventional balloon of Shaknovich, in which *there is no an axial portion of the elongate member disposed between the proximal end of the balloon and the distal end of the stent that is free of contact with the wall surface of the body vessel.*

The Examiner agreed that the amendments made herein to independent Claim 1 overcame the prior art of record, including Shaknovich.

Amendments to the Claims

Applicants have herein amended independent claim 1 to require that the step of spacing a portion of the elongate member from a wall surface of the body vessel be conducted “such that an axial portion of the elongate member disposed between the proximal end of the means for spacing and the distal end of the intraluminal medical device is free of contact with the wall surface of the body vessel.” Applicants have also amended claim 1 to add proper antecedent basis for the newly added “proximal end of the means for spacing” and the “distal end of the intraluminal medical device.”

These amendments to the claims are fully supported by the application as

filed; no new matter has been introduced. Exemplary support is found in Figures 5 and 6 and the accompanying discussion.

Applicants have also herein canceled claims 13, 14, and 18, drawn to an apparatus, solely to focus prosecution on the method defined by the remaining claims. The cancellation of these claims is done without prejudice and is not considered limiting in any manner.

Rejection of Claims 1, 2 and 8 under 35 U.S.C. §102

The Examiner rejected Claims 1, 2 and 8 under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 5,807,398 to Shaknovich ("Shaknovich"). Specifically, the Examiner indicated that Shaknovic "discloses a method for delivering and deploying an expandable intraluminal device" that includes the steps recited in Claims 1, 2 and 8 of the present application for patent.

Shaknovich teaches a delivery system that is suitable for use in "pre-dilatation," a technique used in some stent deployments to pre-dilate an occluded portion of a vessel prior to deployment of the stent at the occlusion.

As amended herein and described above, independent claim 1, from which all remaining claims depend, specifically requires that the step of spacing a portion of the elongate member from a wall surface of the body vessel be conducted "such that an axial portion of the elongate member disposed between the proximal end of the means for spacing and the distal end of the intraluminal medical device is free of contact with the wall surface of the body vessel." Also, claim 1 still requires that the step of deploying the expandable intraluminal medical device be conducted while the elongate member is being spaced from a wall surface of the body vessel.

Because the balloon of Shaknovich, which accomplishes the spacing of the elongate member from the vessel wall as interpreted by the Examiner, is situated *directly under* the stent during deployment, the Shaknovich device is not capable of spacing an axial portion of the elongate member from the vessel wall that is disposed between the proximal end of the balloon and the distal end of the stent. Indeed, as Figure 5 clearly shows, there is no axial portion of the elongate member disposed between the proximal end of the balloon and the distal end of the stent.

Thorough review of Shaknovich reveals a complete absence of any teaching of such a spacing step. As such, the reference does not anticipate Claim 1 or related dependent claim. The Applicants respectfully request withdrawal of this rejection of the claims.

Rejection of Claims 4 and 11 under 35 U.S.C. §103

The Examiner rejected Claims 4 and 11 under 35 U.S.C. §103(a) as being unpatentably obvious over Shaknovich in view of United States Patent No. 5,807,398 to Kirkman ("Kirkman"). Specifically, the Examiner indicated that Shaknovich "discloses the claimed invention except for the means for spacing comprising a basket formed from four wires having expanded and collapsed configurations and the step of activating the means for spacing includes retracting the sheath from a position about the means for spacing."

Both claims 4 and 11 depend from Claim 1 and, therefore, include all limitations of that claim. As described above, Claim 1 has been amended herein to require that the step of spacing a portion of the elongate member from a wall surface of the body vessel be conducted "such that an axial portion of the elongate member disposed between the proximal end of the means for spacing and the distal end of the intraluminal medical device is free of contact with the

wall surface of the body vessel."

Also as described above, Shaknovich does not teach or suggest such a spacing step. Kirkman fails to cure this defect of Shaknovich and, as such, the rejection does not present a *prima facie* case of obviousness because it fails to teach or suggest each and every limitation of the rejected claims.

Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 4 and 11 in light of the amendments made herein.

Rejection of Claim 12 under 35 U.S.C. §103

The Examiner rejected Claim 12 under 35 U.S.C. §103(a) as being unpatentably obvious over Shaknovich in view of United States Published Application No. 20010039450 to Pavcnik ("Pavcnik"). Specifically, the Examiner indicated that Shaknovich "discloses the claimed steps except for the expandable intraluminal medical device comprising a venous valve."

Claim 12 depends from Claim 1 and, therefore, includes all limitations of that claim. As described above, Claim 1 has been amended herein to require that the step of spacing a portion of the elongate member from a wall surface of the body vessel be conducted "such that an axial portion of the elongate member disposed between the proximal end of the means for spacing and the distal end of the intraluminal medical device is free of contact with the wall surface of the body vessel."

Also as described above, Shaknovich does not teach or suggest such a spacing step. Pavcnik fails to cure this defect of Shaknovich and, as such, the rejection does not present a *prima facie* case of obviousness because it fails to teach or suggest each and every limitation of the rejected claims.

Applicants respectfully request reconsideration and withdrawal of the rejection of Claim 12 in light of the amendments made herein.

Rejection of Claims 13 and 14 under 35 U.S.C. §103

The Examiner rejected Claim 14 under 35 U.S.C. §103(a) as being unpatentably obvious over Kirkman in view of United States Published Application No. 20040087965 to Levine ("Levine"). The Applicants have herein canceled claims 13 and 14 without prejudice. The rejection of these claims is, therefore, moot and should be withdrawn.

Rejection of Claim 18 under 35 U.S.C. §103

The Examiner rejected Claim 18 under 35 U.S.C. §103(a) as being unpatentably obvious over Kirkman in view of United States Published Application No. 20010039450 to Pavcnik ("Pavcnik"). The Applicants have herein canceled claim 18 without prejudice. The rejection of this claim is, therefore, moot and should be withdrawn.

CONCLUSION

The Applicants have fully responded to the rejections listed by the Examiner in the June 18, 2008, Office Action. Applicants respectfully assert that all outstanding rejections have been overcome and that all pending claims define patentable subject matter.

A Notice of Allowability is appropriate and requested.

Should the Examiner have any questions regarding this Reply and Amendment, or the remarks contained herein, the undersigned attorney would welcome the opportunity to discuss such matters with the Examiner.

Respectfully submitted,

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